

Remarks

Claims 1-43 continue to stand rejected under 35 U.S.C. §102(a) as being anticipated by Novell's "Digitalme" publication dated October 5, 1999 (hereinafter "Novell"). Applicants originally traversed these rejections (in response to the first Office Action dated September 15, 2004) because the invention, as recited in claims 1-43, was conceived and the inventors were diligent in reducing the invention to practice prior to the effective date of Novell until the invention was actually reduced to practice when the provisional patent application was filed on January 14, 2000. In support of Applicants' position, one of the co-inventors, Jonathan Bari, executed a Declaration Under 37 C.F.R. § 1.131, which established that the inventions recited in claims 1-43 were conceived at least by April 1999 and were diligently reduced to practice at least through July 1999, which was before the publication of Novell on October 5, 1999 ("the *Critical Date*"). In Response to Applicants' traversal (which actually was originally filed on November 19, 2004, was incorrectly not entered by the Patent Office, and was re-filed by Applicants on June 20, 2005), the Examiner found that the evidence submitted was insufficient to establish a conception of the invention prior to the effective date of Novell.

Applicants request reconsideration of the rejection of claims 1-43 as being anticipated by Novell, and submit further evidence that Applicants conceived the inventions and were diligent in reducing the inventions to practice prior to the Critical Date of Novell until the provisional patent application, upon which the present utility patent application claims priority, was filed. Specifically, co-inventors Jonathan Bari and Scott Elkins submit declarations outlining their

conception and continuous diligent reduction to practice; Michael Aregood submits a declaration outlining the communications he had with Mr. Bari to discuss the design of a graphical user interface (“GUI”) for a Web site and related marketing materials that encompass the conception of the invention; and Leslie S. Bari submits a declaration outlining her meetings and communications with Mr. Bari in which he disclosed the concept of the invention and instructed her assistance in performing market research regarding the concept and her assistance in creating the Executive Summary and business documents related to the conception and development of the invention.

The Examiner found the original declaration submitted by Mr. Bari to be insufficient because “while conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another.” In response, Applicants submit the declarations of two of the co-inventors, Jonathan H. Bari and Scott R. Elkins, who both describe the conception process that occurred in late 1998 and early 1999, as well as supply supporting documentation. See Declaration of Jonathan H. Bari, paragraphs 2-4; Declaration of Scott R. Elkins, paragraphs 2-4.

Applicants further submit the declaration of Michael Aregood, who is a graphic artist and designer. Mr. Aregood declares that he met with one of the inventors, Jonathan Bari, shortly after the claimed conception date in April 1999 and Mr. Bari disclosed to him the invention in sufficient detail to allow Mr. Aregood to begin to create a GUI for a Web site that encompassed the conception of the invention. See Declaration of Michael Aregood, paragraph 3; Declaration

of Jonathan H. Bari, paragraph 5. Mr. Aregood further declares that he communicated with Mr. Bari a number of times during 1999 in furtherance of the reduction of practice of the invention, and that on or about October 19, 1999 Mr. Aregood developed the completed version of the GUI based upon the inventors' concept. See Declaration of Michael Aregood, paragraphs 4-6; Declaration of Jonathan H. Bari, paragraphs 9-10.

Applicants also submit the declaration of Leslie S. Bari, who is a marketer and businesswoman. Ms. Bari declares that she worked with Mr. Bari starting in the early part of the second quarter of 1999, during which Mr. Bari described the concept of the invention. See Declaration of Leslie S. Bari, paragraph 2; Declaration of Jonathan H. Bari, paragraph 7. Ms. Bari further declares that starting in July 1999, Mr. Bari requested that she perform market research regarding the invention, and also requested that she assist in creating the Executive Summary and a presentation that related to the conception and development of the invention. See Declaration of Leslie S. Bari, paragraphs 3-5, Declaration of Jonathan H. Bari, paragraph 7.

Thus, Applicants provide ample evidence that they conceived of the invention in late 1998 and early 1999 since they made complete disclosure of the invention to at least two other people who were then employed to aid in the reduction to practice of the invention.

The Office Action further finds the evidence submitted in the original Request for Reconsideration to be insufficient because it failed to establish diligence from a date prior to the date of reduction to practice of Novell to a reduction to practice of the present invention. In response, the declarations of the co-inventors, Mr. Aregood, and Ms. Bari all illustrate constant

development of the invention from the time of conception (late 1998 to early 1999) until reduction to practice (when the provisional application was filed in January 2000). Mr. Bari and Mr. Elkins outline the diligence through their declarations – after conception, Mr. Aregood, was hired in April 1999 to create a graphical user interface for a Web site and related marketing materials that encompass the conception. From April to June 1999, the Executive Summary for the company that was to be the vehicle through the invention would be developed and commercialized was drafted and in July 1999 market research was conducted. At the end of July 1999 a Web site was registered for the company. The Web site was to be the online “home” for the invention as claimed. The Executive Summary and a slide presentation outlining the invention was completed in August 1999, and by the end of September more information was conveyed to the graphic artist for further screen shots encompassing the invention, and for marketing materials. The screen shots were completed by the end of October 1999, and by the end of November 1999 the first two working prototypes of the invention were complete. During December 1999 and January 2000, Applicants refined the invention, and professional service providers, vendors, software developers, etc. were contacted in furtherance of the development of the inventive product. See Declaration of Jonathan H. Bari, paragraphs 5-13; Declaration of Scott R. Elkins, paragraphs 5-9. The Declarations of Mr. Aregood and Ms. Bari corroborate the inventors’ statements. See Declaration of Michael Aregood, paragraphs 3-7; Declaration of Leslie S. Bari, paragraphs 3-7.

Thus, Applicants respectfully assert that they have presented sufficient evidence to establish diligence from a date prior to the date of reduction to practice of Novell (October 5, 1999) until the provisional patent application for the present invention was filed on January 14, 2000. Therefore, for at least the above reasons, Applicants respectfully request that the rejections of claims 1-43 under 35 U.S.C. § 102(a) be withdrawn.

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration of the application and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the response; the Examiner is invited to contact the Applicants' undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

By: Mary Jane Boswell
Mary Jane Boswell
Reg. No. 33,652

Dated: January 5, 2006

MORGAN, LEWIS & BOCKIUS LLP
1111 Pennsylvania Ave. NW
Washington, DC 20004
202-739-3000